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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,953	02/04/2004	John Gibney	10086-03CIP	5314

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EXAMINER

MANAF, ABDUL

ART UNIT PAPER NUMBER

3635

DATE MAILED: 11/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/772,953

Applicant(s)

GIBNEY ET AL.

Examiner

Abdul Manaf

Art Unit

3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 23-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>02/04/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claim 23 – 25 are drawn to method of protecting surfaces, classified in class 428, subclass 40.1.
- II. Claims 1 – 22 drawn to a protective device, classified in class 52, subclass 746.1.

The inventions are distinct, each from the other because of the following reasons:

Inventions method of protecting surfaces and protective device are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Attorney Larry Meier on October 19, 2005 a provisional election was made with traverse to prosecute the invention of group II, claims 1- 22 and 26 - 31. Mr. Larry Meier's name is not found in previously submitted documents by the applicant. A change in power of attorney and Mr. Larry Meier's should be submitted. Affirmation of this election must be made by applicant in replying to this

Art Unit: 3635

Office action. Claims 23-25 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 – 6, 8, 9, 11 – 13, 15 – 21, 26 - 30 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 – 3, 7, 8, 10, 11, 21, 38, 41, 43 and 44 of copending Application No. 10,606,083.

This is a provisional obviousness-type double patenting rejection.

Regarding claim 1, Application No. 10,606,083 claims a protective device comprising a protective-sheet formed from a material (claim 1) having a plurality of strips affixed to the protective-sheet (claim 1) formed from another material (claim 7) and a flap portion (claim 3) having an adhesive (claim 2). However, '083 does not claim

Art Unit: 3635

a removable top-sheet. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify '083 by using a top-sheet to protect adhesive from drying during the transportation.

Regarding claim 2, '083 claim adhesive strips to attach with protective-sheet (claim 8).

Regarding claim 3, '083 claim strips having a thickness of 1/16 to 1 inch (claim 10).

Regarding claim 4, '083 claim strips having a width from 1/16 inch to 3 inches. (claim 21). Applicant fails to show criticality for specifically claimed dimensions, therefore it would have been an obvious design choice to use the dimensions such as specified in these claims.

Regarding claim 5, '083 claim strips having a length of about 1 foot to 8 feet (claim 21). Applicant fails to show criticality for specifically claimed dimensions, therefore it would have been an obvious design choice to use the dimensions such as specified in these claims.

Regarding claim 6, '083 claim strips in a parallel fashion (claim 1).

Regarding claim 8, '083 claim a protective device comprising a protective-sheet formed from a material having a plurality of protective portions (strips) (claim 11) is formed from another material (claims 1, 7).

Regarding claim 9, '083 claim a plurality of protective portions (strips) spaced from each other (claim 11). The '083 claim a flap portion (claim 3) having an adhesive (claim 2).

Regarding claim 11, '083 claim adhesive protective portions (strips) to attach with protective-sheet (claim 8).

Regarding claim 12, '083 claim protective portions (strips) having a thickness of 1/16 to 1 inch (claim 10).

Regarding claim 13, '083 claim protective portions (strips) having first end, a second end (claim 1), length, width and thickness (claim 21) (rectangular). Applicant fails to show criticality for specifically claimed shapes therefore it would have been an obvious design choice to use the shape such as specified in these claims.

Regarding claim 15, '083 claim a protective device comprising a protective-sheet (claim 1) having a plurality of strips affixed to the protective-sheet (claim 1) and a flap portion (claim 3) having an adhesive (claim 2).

Regarding claim 16, '083 claim a plurality of strips spaced from each other (claim 11).

Regarding claim 17, '083 claim adhesive strips to attach with protective-sheet (claim 8).

Regarding claim 18, '083 claim strips having a thickness of 1/16 to 1 inch (claim 10).

Regarding claim 19, '083 claim strips having a width from 1/16 inch to 3 inches (claim 21). Applicant fails to show criticality for specifically claimed dimensions, therefore it would have been an obvious design choice to use the dimensions such as specified in these claims.

Regarding claim 20, '083 claim strips having a length of about 1 foot to 8 feet (claim 21). Applicant fails to show criticality for specifically claimed dimensions, therefore it would have been an obvious design choice to use the dimensions such as specified in these claims.

Regarding claim 21, '083 claim strips in a parallel fashion (claim 1).

Regarding claim 26, '083 claim a method of providing a protective device comprising a protective-sheet formed from a material (claims 38), a plurality of protective portions (strips) formed from another material (claims 41) where strips are affixed to the sheet (claims 38). The '083 claim a flap portion (claim 38).

Regarding claim 27, '083 claim a method of providing a flap portion (claim 38) having an adhesive (claim 38).

Regarding claim 28, '083 claim a method of providing adhesive strips to attach with protective-sheet (claim 43).

Regarding claim 29, '083 claim a method of providing protective portions (strips) having first end, a second end (claim 1), length, width and thickness (claim 21) (rectangular). Applicant fails to show criticality for specifically claimed shapes therefore it would have been an obvious design choice to use the shape such as specified in these claims.

Regarding claim 30, '083 claim a method of providing a plurality of protective portions (strips) spaced from each other (claim 44) affixed to the protective-sheet surface.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2 – 6, 8, 11 – 13, 16 – 21, 26, 28 - 30 are rejected under 35 U.S.C.

103(a) as being unpatentable over the U.S. Patent No. 2,587,985 to Elmendorf.

Regarding claim 2, Elmendorf discloses strips (Fig. 6: 3) bounded to the protective-sheet front side (Figs. 6: 3; column 3, lines: 58-64).

Regarding claim 3, Elmendorf discloses strips having a thickness between 1/16 and one inch (column 2, lines: 38-40).

Regarding claim 4, Elmendorf discloses strips having width between 1/16 and 3 inches (column 2, lines: 38-40). Applicant fails to show criticality for specifically claimed dimensions, therefore it would have been an obvious design choice to use the dimensions such as specified in these claims.

Regarding claim 5, Elmendorf discloses a paper comprising continuous strips having any required length (column 2, lines: 26-31; column 6, lines: 12-14).

Regarding claim 6, Elmendorf discloses a plurality of strips affixed to the sheet in a parallel fashion (Fig. 6: 4a).

Regarding claim 8, Elmendorf discloses a flexible protective-sheet of a material (column 2, lines: 10-12) comprising an adhesive (column 3, lines: 58-64), a plurality of protective portions (strips) having a distance between them affixed to the protective-

sheet (Fig. 6: 3; column 4, lines: 40-53). Elmendorf discloses protective portions (strips) made from another material (column 2, lines: 26-30).

Regarding claim 11, Elmendorf discloses protective portions (strips) bounded to the protective-sheet (column 3, lines: 58-64).

Regarding claim 12, Elmendorf discloses protective portions (strips) having a thickness between 1/16 and one inch (column 2, lines: 38-40).

Regarding claim 13, Elmendorf discloses protective portions (strips) having a rectangular shape (Fig. 6: 4a).

Regarding claim 16, Elmendorf discloses evenly spaced strips (Figs. 6: 4a) where the space between strips is exposed.

Regarding claim 17, Elmendorf discloses strips bounded to the protective-sheet (column 3, lines: 58-64).

Regarding claim 18, Elmendorf discloses strips having a thickness between 1/16 and one inch (column 2, lines: 38-40).

Regarding claim 19, Elmendorf discloses strips having width between 1/16 and 3 inches (column 2, lines: 38-40). Applicant fails to show criticality for specifically claimed dimensions, therefore it would have been an obvious design choice to use the dimensions such as specified in these claims.

Regarding claim 20, Elmendorf discloses a paper comprising continuous strips having any required length (column 2, lines: 26-31; column 6, lines: 12-14).

Regarding claim 21, Elmendorf discloses a plurality of strips affixed to the sheet in a parallel fashion (Fig. 6: 4a).

Regarding claim 26, Elmendorf discloses a method of providing a protective-sheet of a material (column 2, lines: 10-12) comprising an adhesive (column 3, lines: 58-64), a plurality of protective portions (strips) having a distance between them affixed to the protective-sheet (Fig. 6: 3; column 4, lines: 40-53). Elmendorf discloses protective portions (strips) made from another material (column 2, lines: 26-30).

Regarding claim 28, Elmendorf discloses a method of providing strips bounded to the protective-sheet by using an adhesive (column 3, lines: 58-64).

Regarding claim 29, Elmendorf discloses a method of providing protective portions (strips) having a rectangular shape (Fig. 6: 4a).

Regarding claim 30, Elmendorf discloses a method of providing evenly spaced strips (Figs. 6) where the space between strips is exposed.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The cited patents listed on the included form PTO-892 further show the state of the art with respect to Construction Protection Device and Method of Manufacturing in general.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abdul Manaf whose telephone number is (571) 272-1476. The examiner can normally be reached on Monday-Friday from 7:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman, can be reached at (571) 272-6842.

AM *A.M.*

10/19/2005


Carl D. Friedman
Supervisory Patent Examiner
Group 3600